

REMARKS

Claims 12-28 are pending. Claims 12-15 and 23-28 are under examination. Claims 12 and 28 have been amended. Support for the amendments can be found throughout the specification and the claims as filed. In particular, claim 12 has been amended to incorporate elements of claim 14 in part. Claim 12 has further been amended for consistent antecedent basis. Claim 28 has been amended to update the dependency based on cancellation of claim 15. Accordingly, these amendments do not raise an issue of new matter and entry thereof is respectfully requested.

Applicants wish to thank the Examiner for the constructive telephone conference held December 28, 2009. During the telephone conference, the Examiner suggested amending the claims to voltage-gated sodium channel inhibitors related to tolperisone. Applicants wish to thank the Examiner for this suggestion and have adopted this amendment in this response.

Rejection under 35 U.S.C. §112, first paragraph

The rejection of claims 12-15 and 23-28 under 35 U.S.C. §112, first paragraph as allegedly providing an insufficiently enabling disclosure is respectfully traversed (Office Action at page 2, item 4).

With respect to claim 12, Applicants assert that the specification is sufficiently enabled to support the claim as previously presented. However, in the interest of moving prosecution forward, Applicants have adopted the Examiner's suggested amendment reciting tolperisone and the closely related compounds silperisone and eperisone. Claims 24-26, and 28 depend from claim 12 and further possess the requisite enabling disclosure. The cancellation of claims 13-15, 23, and 27 renders their rejection moot. Applicants respectfully request withdrawal of this rejection.

Rejection under 35 U.S.C. §112, second paragraph

The rejection of claims 14-15 and 27-28 under 35 U.S.C. §112, second paragraph as allegedly being indefinite is respectfully traversed (Office Action at page 5, item 5).

The cancellation of claims 14, 15, and 27 renders their rejection moot. With respect to claim 28, “tolperisone analog” does not appear in this claim, nor in claim 12 from which it depends. Applicants respectfully request withdrawal of the rejection.

Rejection under 35 U.S.C. §103

The rejection of claims 12-13 and 23-28 under 35 U.S.C. §103(a) as allegedly being obvious over Rundfeldt et al. (U.S. 6,117,900) in view of Cai et al. (U.S. 6,281,211) is respectfully traversed (Office Action at page 6, item 6).

This rejection appears to be a *pro forma* rejection based on previous arguments presented by the Examiner, including recitation of the Examiner’s previous remarks at page 9, item 7. Neither Rundfeldt et al. nor Cai et al. teach voltage-gated sodium channel inhibitory activity of tolperisone, eperisone, or silperisone. Moreover, in view of the unpredictability of voltage-gated sodium-ion channels in treating pain, as evidenced by Galer et al. and as acknowledged by the Examiner in this response (see for example page 4, first full paragraph), Applicants assert that claim 12 is not obvious over Rundfeldt et al. in view of Cai et al. Claims 24-26, and 28 depend from claim 12 and are patentable for at least the same reasons. Claims 13, 23, and 27 have been canceled rendering their rejection moot. Applicants respectfully request withdrawal of this rejection.

In light of the amendments and remarks herein, Applicants submit that the claims are now in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to call the undersigned agent if there are any questions.

Without addressing the merits of the rejections set forth in the Office Action mailed January 7, 2010, Applicants have canceled claims 13-15 and 27 without prejudice to Applicants pursuing these claims in a related application.

Application No.: 10/727,655

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

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